



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/470,042      | 12/22/1999  | CHEAH WEE LEONG      | AND1P400            | 5696             |

29838 7590 09/13/2004

OPPENHEIMER WOLFF & DONNELLY, LLP (ACCENTURE)  
PLAZA VII, SUITE 3300  
45 SOUTH SEVENTH STREET  
MINNEAPOLIS, MN 55402-1609

EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/470,042

Applicant(s)

LEONG ET AL.

Examiner

Pierre E. Elisca

Art Unit

3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-24, 26-35, 37-46 and 48-51 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 25, 36 and 47 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office action is in response to Applicant's RCE, filed on 07/07/2004.
2. Claims 19-51 are added.

### ***Allowable Subject Matter***

3. Claims 25, 36 and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19-24, 26-35, 37-46 and 48-51 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Hartheimer et al. (U.S. Pat. No. 5,305,200) in view of Ginter et al (U.S. Pat. No. 6,185,683).

As per claims 19, 21, 22, 23, 24, 26-30, 32-35, 37-41, 43-46 and 48-51 Hartheimer substantially discloses a system/method for distributing online automated trading system uses structured messages to represent each stage in the negotiation between a market (quoter) and a potential buyer or seller (which is seen to read as

Art Unit: 3621

Applicant's claimed invention wherein it is stated that a method for completing a purchase order/invoice (or items), comprising the steps of:

allowing a buyer to select among a plurality of documents associated with proposed transaction (see., abstract, specifically wherein it is stated that online automated trading system uses structured messages to represent each stage in the negotiation between a market (quoter) and a potential buyer or seller, and also col 2, lines 45-68, lines 5-40);

allowing the buyer to indicate requirements (or negotiate) of trade terms of an agreement relating to the documents, wherein the trade terms are presented to a seller on an electronic form via an electronic document platform, such that the electronic form includes a combined purchase order proforma invoice, an electronic transportation document, and an electronic shipping document (see., see., abstract, specifically wherein it is stated that online automated trading system uses structured messages to represent each stage in the negotiation between a market (quoter) and a potential buyer or seller, and also col 2, lines 45-68, col 3, lines 5-40, col 6, lines 5-40. It is obvious to realize that electronic message or document also includes form, shipping and so on);

permitting a seller to at least one of agree to and amend the trade terms on an electronic document platform (see., col 2, lines 45-68, col 6, lines 5-40);

creating a new version of a form delineating the trade terms upon each amendment (see., abstract, col 2, lines 45-68, col 3, lines 5-40);

allowing a negotiation of the trade terms of the agreement between the buyer and the seller (abstract, col 2, lines 45-68, col 6, lines 5-40);

Art Unit: 3621

displaying the form detailing the negotiation of the trade terms (see., abstract, col 2, lines 45-48, specifically wherein it is stated that display and process all relevant details); organizing and storing the documents supporting the form (see., col 5, lines 27-50); initiating payment to the seller only after receiving a verification of credit of the buyer (see., col 2, lines 45-68, please note that after negotiation, a payment must be provided, and also col 3, lines 47-56, col 4, lines 6-15);

organizing and storing documents supporting the form (see., col 5, lines 27-50);

**It is to be noted that Hartheimer fails to explicitly disclose a digital signature of the form of the detailing negotiations, and performing a compliance check, wherein the compliance check is triggered automatically in response to the digital signature of the electronic form, and wherein the compliance check includes both checking the combined purchase order proforma invoice against the electronic transportation document and checking the electronic transportation document against the electronic shipping document.**

**However, Ginter discloses** a trusted and secure techniques, systems and methods for item delivery and execution wherein documents and other items can be delivered electronically from sender to recipient. Documents can be marked with digital signature (see., abstract, col 7, lines 28-38, col 9, lines 40-49, col 23, lines 60-67, col 24, lines 1-10). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the financial exchange of **Hartheimer** by including the limitation detailed above as taught by **Ginter** because such modification would provide a system/method that can affix visible seal on printed items or terms or

Art Unit: 3621

documents such as documents for use both in encoding receipt and other receipt and/or usage related information and for establishing a visible presence and impact regarding the authenticity, and ease of checking the authenticity, of the item. (See., Ginter, col 7, lines 33-38).

**As per claims 20, 31 and 42 Hartheimer** discloses the claimed method, wherein the form includes a first section indicating the terms, a second section for allowing the buyer to sign off on the terms, and a third section for allowing the seller to sign off on the terms (see., abstract, col 2, lines 45-68).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

September 08, 2004